REMARKS

Applicants thank the Examiner for the telephone interview of February 8, 2001, and for the helpful suggestions regarding the claims in this Continuing Prosecution Application. During that discussion, the Examiner explained the analysis scheme that he uses when evaluating inherency issues. As discussed in the phone interview, Applicants have amended method claim 19, canceled method claims 20–22 without prejudice and added new method claim 28. The method claims are now directed toward insertion of a cannula into the aorta or into cardiac tissue. Moreover, Applicants have canceled device claims 1–18 without prejudice.

In the Final Office Action mailed on November 21, 2000 (the "Final Office Action"), the Examiner rejected claims 19 – 27 as unpatentable over Gabbay in view of Miller et al. and Buckberg et al. because "the references . . . disclosed all of the critical elements of the applicants invention." He further stated, citing In re King, "Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device." (Emphasis added.) The emphasized portion of the King citation shown above describes a critical limitation to broadly applying the inherency argument to method claims.

The Examiner cites Miller as disclosing the insertion of a separately insertable filter, noting correctly that "Gabbay does not disclose or suggest insertion of a filter separately insertable through the elongate tubular member." (Final Office Action page 2.) Moreover, Applicants note that Buckberg does not disclose a filter. However, the device of Miller, as Applicants discussed with the Examiner during the telephone interview, "in its normal and usual operation" is directed toward a vena cava filter. (For instance, see the numerous references to a vena cava filter in the five objectives of the application described in the Summary of Invention.)

It is clear from the specification that the "normal and usual operation" of the device of Miller is for vena cava filtering during arthroscopy, and particularly during hip replacement. There is no disclosure of the step of inserting the distal end of a cannula into the aorta or into cardiac tissue in Miller.

Applicants' counsel and the Examiner agreed upon the above–described limitation to applying the inherency argument when rejecting method claims. Applicants' method claims in this Continuing Prosecution Application now include the step of inserting the distal end of the cannula into either the aorta (amended claim 19) or cardiac tissue (new claim 28).

Pending claims 23–27 depend from amended claim 19 either directly or indirectly and thus are not anticipated by the references cited by the Examiner for the same reasons advanced for amended claim 19.

Applicants have added a description of Figures 49–51, inadvertently left out of the specification at the time of filing. Applicants note that the figure descriptions added by this amendment describe figures submitted in the application at filing. Moreover, the present application is a continuation of U.S. Patent No. 6,176,851, incorporated into the present application by reference in its entirety, and the language of the description added by this Amendment to the present application is identical to the description of Figures 49–51 in U.S. Patent No. 6,176,851. Thus, no new matter has been added to the specification of the present application by this amendment.

Favorable action on the merits of the claims of this Continuing Prosecution Application is respectfully requested. The Commissioner is hereby authorized to charge any additional fees, which may be required, to Deposit Account No. 12–2475.

Respectfully submitted,

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